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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,149	12/14/2001	Paul A. Flaherty	M-8631 US	1681

7590 04/21/2004

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,149

Applicant(s)

FLAHERTY, PAUL A.

Examiner

Pierre E. Elisca

Art Unit

3621

14

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3621

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 01/27/2004.
2. Claims 1- 22 are remained and claims 23-32 are added.
3. The rejection to claims 1-22 under 35 U.S.C. 103 (a) as being unpatentable over Hendrey in view of Kubon as set forth in the Office action mailed on 08/18/2003 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Hendrey et al. (U.S. Pat. No. 6,542,750) in view of Kubon (6,135,354).

As per claims 1-6 and 8-9 Hendrey substantially discloses a method/system for selectively connecting proximately located telecommunications units (which is readable

Art Unit: 3621

as Applicant's claimed invention wherein it is stated that a communication application executable on a network), comprising:

a client process executable on a processor in a two-way communication device, the two-way communication device (see., abstract, fig 1, col 2, lines 40-67, col 5, lines 26-67, col 6, lines 1-67, specifically Mus 101a-c);

a server process executable on a processor communicatively coupled over the network to the client process (see., abstract, figs 1 and 3, col 7, lines 61-67, col 8, lines 1-49); and

coupon depository or storage coupled to the server process capable of storing a plurality of particular coupons (see., col 15, lines 30-53, specifically scenario 1, database 143, e-coupons). It is to be noted that Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image. However, Kubon discloses a barcode image processing system which processes video signals including video data representing images of barcode labels to be decoded and verified. The image of the barcode label can be displayed on the video camera (or telephone) see., abstract, col 7, lines 13-41, fig 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mobile communications of Hendrey by including the limitation detailed above as taught by Kubon because such modification would verify and report unauthorized users within the telecommunication network.

Art Unit: 3621

As per claim 7, Hendrey discloses the claimed limitations wherein the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers (see., abstract, fig 1, col 2, lines 40-67, col 5, lines 26-67, col 6, lines 1-67, specifically Mus 101a-c).

As per claims 10-12 and 14-32 Hendrey substantially discloses a method/system for selectively connecting proximately located telecommunications units (which is readable as Applicant's claimed invention wherein it is stated that a communication application executable on a network), comprising:

a client process executable on a processor in a two-way communication device, the two-way communication device (see., abstract, fig 1, col 2, lines 40-67, col 5, lines 26-67, col 6, lines 1-67, specifically Mus 101a-c);

an interactive input process capable of receiving input signals from the two-way communication device (see., abstract, figs 1 and 3, col 7, lines 61-67, col 8, lines 1-49);

a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network (see., abstract, figs 1 and 3, col 7, lines 61-67, col 8, lines 1-49); and

a communication receiving process responsive to communication signals from the process for receiving coupon information from the server process (see., col 15, lines 30-

Art Unit: 3621

53, specifically scenario 1, database 143, e-coupons). Hendrey further discloses a coupon repository for storing a plurality of coupons (see., col 15, lines 30-53, specifically scenario 1, database 143, e-coupons). It is to be noted that Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image. However, Kubon discloses a barcode image processing system which processes video signals including video data representing images of barcode labels to be decoded and verified. The image of the barcode label can be displayed on the video camera (or telephone) see., abstract, col 7, lines 13-41, fig 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mobile communications of Hendrey by including the limitation detailed above as taught by Kubon because such modification would verify and report unauthorized users within the telecommunication network.

As per claims 13 and 22, Hendrey discloses the claimed limitations wherein the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers (see., abstract, fig 1, col 2, lines 40-67, col 5, lines 26-67, col 6, lines 1-67, specifically Mus 101a-c).

RESPONSE TO ARGUMENTS

Art Unit: 3621

6. Applicant's arguments filed on 01/27/2004 have been fully considered but they are not persuasive.

REMARKS

7. In response to applicant's arguments, Applicant argues that the prior art of record (Hendrey 750" and Kubon 354") taken alone or in combination fail to anticipate or render obvious the recited feature:

a. " In order to establish a prima facie case of obviousness, there must be shown a suggestion or motivation in the reference or in the knowledge of one with ordinary skill in the art, to modify or combine the references and the prior art references must teach or suggest all of the claim limitation". However, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re* Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In *re* Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In *re* Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In *re* Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte* Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and *Es parte* Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte* Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In *re* Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In *re* Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. "The two references do not show a coupon including a bar code image". As indicated above, Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image. However, Kubon discloses a barcode image processing system which

Art Unit: 2785

processes video signals including video data representing images of barcode labels to be decoded and verified. The image of the barcode label can be displayed on the video camera (or telephone) see., abstract, col 7, lines 13-41, fig 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mobile communications of Hendrey by including the limitation detailed above as taught by Kubon because such modification would verify and report unauthorized users within the telecommunication network.

c. " coupon depository". As noted above, Hendrey discloses this limitation in col 15, lines 30-53, specifically scenario 1, database 143, e-coupons).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary patent Examiner

April 19, 2004